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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,876	11/30/2001	Thomas Baumann	033275-300	2763

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EXAMINER	
LAZOR, MICHELLE A	
ART UNIT	**PAPER NUMBER**
1734	

DATE MAILED: 03/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/996,876	BAUMANN ET AL.	
	Examiner	Art Unit	
	Michelle A Lazor	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) *14-18* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 – 5 and 10 – 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kiyoshi et al. (JP 02185975).

Regarding Claims 1 – 5, Kiyoshi et al. disclose a device comprising positioning means and a magnetic field generation means that generates forces that act contactless on the component in at least one section to be processed and in this way bring about or support the positioning of the component, wherein the magnetic field generation means are constructed so that the forces generated by the magnetic field counteract the force of the weight of the component and is constructed in such a way that the size of the forces generated by the magnetic field are such that they essentially compensate a gravity-induced bending of the component at least in a section to be processed and the forces generated by the magnetic field have components that are oriented transversely to the force of gravity and act symmetrically on the component and center it (Figure 1; English translation Abstract). Thus Kiyoshi et al. disclose all the limitations of Claims 1 – 5, and anticipate the claimed invention.

Regarding Claims 10 and 11, the apparatus of Kiyoshi et al. is capable of processing an electrical conductor or conductor bundle of a rotating electrical machine. Thus Kiyoshi et al. disclose all the limitations of Claims 10 and 11, and anticipate the claimed invention.

Regarding Claims 12 and 13, Kiyoshi et al. disclose using a spraying or coating process (Figure 1; English translation Abstract), which is capable of coating an electrical insulation onto the substrate or component. Thus Kiyoshi et al. disclose all the limitations of Claims 12 and 13, and anticipate the claimed invention.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1 – 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nijsse et al. (WO 99/17034) in view of Kiyoshi et al.

Regarding Claims 1 – 5, 12, and 13, Nijsse et al. disclose a device comprising positioning means and a magnetic field generation means that generates forces that act contactless on the component in at least one section and in this way bring about or support the positioning of the component, wherein the magnetic field generation means are constructed so that the forces generated by the magnetic field counteract the force of the weight of the component and is constructed in such a way that the size of the forces generated by the magnetic field are such that they essentially compensate a gravity-induced bending of the component at least in a section to

be processed and the forces generated by the magnetic field have components that are oriented transversely to the force of gravity and act symmetrically on the component and center it (page 1, paragraph 1; page 2, paragraphs 1 – 4; and page 14, paragraph 3), but does not specifically disclose the component to be processed in a processing position, including a spraying process. However, Kiyoshi et al. disclose using a spraying or coating process (Figure 1; English translation Abstract), which is capable of coating an electrical insulation onto the substrate or component. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use the apparatus disclosed by Nijsee et al. in a processing system such as one disclosed by Kiyoshi et al. to improve the coating quality and more easily coat the entire object or substrate without imposing any coating defects caused by holding means.

Regarding Claims 6 and 7, Nijsse et al. disclose the magnetic field generation means which are provided with an electrical conductor arrangement of at least one electrical conductor constructed in the form of a coil around a core of ferromagnetic material, whereby the conductor arrangement is connected to a power supply and extends above or below the component in the same direction as the component (Figure 9), and that the magnetic field generation means are provided with electrical connection means with which the component can be connected to a power supply, whereby for the positioning of the component in its processing position the conductor arrangement and the component are supplied with power in such a way that between the component and the conductor arrangement a repelling force or attractive force is generated, which brings about or supports the positioning of the component (Figure 8B; page 12, paragraph 1).

Regarding Claims 8 and 9, Nijsse et al. disclose the positioning means are provided with holding means that fix the component to be processed at its end sections in its processing position, wherein the holding means at the same time form the electrical connection means (Figures 7A, 7B, 8A, and 8B).

Regarding Claims 10 and 11, the apparatus of Nijsse et al. is capable of processing an electrical conductor or conductor bundle of a rotating electrical machine.

5. Claims 1 – 6 and 10 – 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ooyama et al. (EP 1035643) in view of Kiyoshi et al.

Regarding Claims 1 – 5, 12, and 13, Ooyama et al. disclose a device comprising positioning means and a magnetic field generation means that generates forces that act contactless on the component in at least one section to be processed and in this way bring about or support the positioning of the component, wherein the magnetic field generation means are constructed so that the forces generated by the magnetic field counteract the force of the weight of the component and is constructed in such a way that the size of the forces generated by the magnetic field are such that they essentially compensate a gravity-induced bending of the component at least in a section to be processed and the forces generated by the magnetic field have components that are oriented transversely to the force of gravity and act symmetrically on the component and center it (Figure 1; column 1, paragraphs 1 – 2), but does not specifically disclose the component to be processed in a processing position, including a spraying process. However, Kiyoshi et al. disclose using a spraying or coating process (Figure 1; English translation Abstract), which is capable of coating an electrical insulation onto the substrate or component. Therefore it would have been obvious to one of ordinary skill in the art at the time

of the invention to use the apparatus disclosed by Ooyama et al. in a processing system such as one disclosed by Kiyoshi et al. to improve the coating quality and more easily coat the entire object or substrate without imposing any coating defects caused by holding means.

Regarding Claim 6, Ooyama et al. disclose the magnetic field generation means which are provided with an electrical conductor arrangement of at least one electrical conductor, whereby the conductor arrangement is connected to a power supply and extends above or below the component in the same direction as the component (Figure 9), and that the magnetic field generation means are provided with electrical connection means with which the component can be connected to a power supply, whereby for the positioning of the component in its processing position the conductor arrangement and the component are supplied with power in such a way that between the component and the conductor arrangement a repelling force or attractive force is generated, which brings about or supports the positioning of the component (columns 1 – 2, paragraphs 3 – 4).

Regarding Claims 10 and 11, the apparatus of Ooyama et al. is capable of processing an electrical conductor or conductor bundle of a rotating electrical machine.

Response to Arguments

6. In response to applicant's argument that the component to be processed is itself, a magnet to be positioned, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making,

the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

7. In addition, the apparatus disclosed by Ooyama et al. is considered to be able to prevent a component from gravity induced bending. Even if the apparatus is placed along several positions along a component as suggested by the Applicant, the apparatus disclosed would avoid mechanical contact between the apparatus and a component, as shown in Figure 1. Therefore Ooyama et al. in view of Kiyoshi et al., render claims 1 – 6 and 10 – 13 unpatentable, as discussed above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle A Lazor whose telephone number is 571-272-1232. The examiner can normally be reached on Mon - Wed 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MAL
3/15/04

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